Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS JANZEN

Appeal No. 2001-1276
Application No. 09/122,519

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 7, 12 through 14, and 16. Claims 8 through 11, 15, and 17 through 19, the only other claims in the application, stand withdrawn from consideration by the examiner as being based upon

which appears in "APPENDIX I" to the main brief (Paper No. 17).

The following rejection is before us for review.

Claims 1 through 7, 12 through 14, and 16 stand rejected under 35 U.S.C. § 112 (indefiniteness and enablement) .

The full text of the examiner's rejection and response to the argument presented by appellant appears in the answer (Paper No. 18), while the complete statement of appellant's argument can be found in the main and reply[1] briefs (Paper Nos. 17 and 20).

In the reply brief (page 1), appellant acknowledges that the rejected claims stand or fall together. Therefore, our focus, infra, will be upon argued independent claim 1, with the dependent claims standing or falling therewith.

OPINION

In reaching our conclusion on the indefiniteness and enablement issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claim 1, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We are constrained to sustain the rejection of appellant's claim 1 under 35 U.S.C. § 112, as well as the rejection of the dependent claims, which latter claims stand or fall with claim 1 as earlier indicated. Our reasons appear below.

While the examiner has failed to denote the particular paragraphs of 35 U.S.C. § 112 at issue, the content of the rejection (final rejection; page 2) makes it apparent that 35 U.S.C. § 112, second paragraph (indefiniteness) and 35 U.S.C.

Indefiniteness

As set forth in the final rejection (page 2), the examiner considers the recitation of "or" followed by the recitation of "and/or" in claim 1 to render the claim indefinite. We agree.

In the context used in claim 1, "or" appears to indicate that a holding device is, alternatively, means establishing a magnetic field passing through "the" conveyor belt or means generating a vacuum at suction orifices of "the" conveyor belt. However, later in the claim, the holding device is recited as having at least one magnetic device with a magnetic conveyor belt and at least one vacuum device with a vacuum conveyor belt, with the magnetic device "and/or" the vacuum device together with their respective belt being displaced relative to a common reference member and being brought into contact with the workpieces to be transported. The disparity between the discussed recitations in the claim makes it apparent to us that

For the reasons given above, the assertion by appellant (main brief, page 6) that the content of claim 1 before us on appeal satisfies the requirements of 35 U.S.C. § 112, second paragraph, is not well founded.

Enablement

The examiner is of the view (final rejection, page 2) that the claims are based upon "an inadequate disclosure because it has not been sufficiently disclosed as to structurally how both the magnetic conveyor and the vacuum conveyor can be mounted for displacement as required by lines 10-12 of claim 1."

Appellant refers us to portions of the specification (main brief, page 4) revealing that the magnetic device and the vacuum device can be displaced and brought into contact with a workpiece, but acknowledges in the reply brief (page 2) that only one of the belts 1 or 2 is raised or lowered relative to the

made to be selectively movable or be made to move simultaneously together, as claimed.

The test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974). The experimentation required, in addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. See In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 218 (CCPA 1976).

A reading of the specification and a review of the drawing reveals to us that one having ordinary skill in this art would not have been fairly instructed as to how to make and use an apparatus wherein a magnetic device "and/or" (claim 1) a vacuum

that independent and simultaneous operating systems for vacuum and magnetic devices were known in the art at the time of appellant's invention or that one having ordinary skill in the art would have been able to make and use the claimed invention without undue experimentation, based upon the present disclosure. The argument of appellant as set forth in the main and reply briefs simply does not persuade us that the present disclosure satisfies the enablement requirement of the first paragraph of 35 U.S.C. § 112. For the foregoing reasons, the examiner's enablement rejection must be sustained.

In summary, this panel of the board has sustained the rejection under 35 U.S.C. § 112.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)

ICC/LBG

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